

REMARKS

Claims 17, 19 to 28 and 32 to 35 are pending in the application, with Claims 1 to 16, 18 and 29 to 31 having been canceled, with Claims 17, 21, 23, and 25 to 28 having been amended, and with Claims 32 to 35 having been added. Claims 17 and 25 to 28 are the pending independent claims. Reconsideration and further examination are respectfully requested.

Claims 27 to 31 were objected to for an informality with respect to the use of the term "OS". Applicants respectfully submit that the amendments to Claims 27 and 28, along with the cancellation of Claims 29 to 31 herein, render moot the foregoing objection. Accordingly, reconsideration and withdrawal of the objection to Claims 27 to 31 are respectfully requested.

Claims 21 and 23 were rejected under 35 U.S.C. § 112, second paragraph, and also under § 101, for allegedly setting forth a "use" without being a proper process/method claim. Applicants respectfully submit that the foregoing rejections of Claims 21 and 23 are improper and should be withdrawn. In particular, dependent Claims 21 and 23 are apparatus claims which depend, either directly or indirectly, from independent Claim 17 and which include further features. Neither of dependent Claims 21 and 23 describe a "use" as alleged in the Office Action, but instead further define the sticker printing apparatus of independent Claim 17 with additional features.

Amended dependent Claim 21 further adds the feature that the sticker has a form which includes a header, a main body, and an insertion portion, and that the input means inputs respective character strings for the header, main body, and insertion portion. Accordingly, dependent Claim 21 clearly further defines the input means of the apparatus of independent Claim 17. Similarly, amended dependent Claim 23 includes the features of

Claims 17, 21 and 22, and further adds the feature of a setting means for setting whether or not to insert the insertion portion into the form, wherein in a case that the setting means sets to insert the insertion portion into the form, a part of the stickers in one sheet are printed with the insertion portion inserted into the form. Accordingly, dependent Claim 23 clearly further defines the apparatus of independent Claim 17 by adding the setting means which controls whether the insertion portion is inserted into the printed form.

In view of the above, dependent Claims 21 and 23 are clearly not intended to encompass a method or process for “using” an apparatus or a sticker form, but instead clearly define an apparatus which further adds functional features to the apparatus of independent Claim 17. M.P.E.P. § 2173.05(q). Unlike Claims 21 and 23 which are clearly directed to an apparatus, the cases cited by the Examiner involve claims in which the preamble clearly begins with “*the use of a*” thing. (See M.P.E.P. § 2173.05(q), Ex parte Dunki, 153 USPQ 678 (Bd. App. 1967) (‘*[t]he use of a high carbon austenitic iron alloy*’), and Clinical Products Ltd. v. Brenner, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966), (‘*[t]he use of a sustained release therapeutic agent*’). Accordingly, reconsideration and withdrawal of the § 112, second paragraph, and § 101 rejections of amended Claims 21 and 23 are respectfully requested.

Claims 17 to 31 were rejected under § 103(a) over U.S. Patent No. 5,913,019 (Attenberg) in view of U.S. Patent No. 5,487,010 (Drake). Reconsideration and withdrawal of the foregoing § 103 rejections of Claims 17 to 31 are respectfully requested.

Turning to specific claim language, amended independent Claim 17 is directed to a sticker printing apparatus for printing a desired sticker by operating a touch panel overlaid on a display screen, the apparatus including selection means for selecting one of a plurality of background patterns displayed on the display screen by using the touch

panel, background image display means for displaying on the display screen a background image corresponding to the pattern selected by the selection means, input means for inputting a plurality of character strings to be printed on a sticker, in association with a logical layer, control means for generating bit image data corresponding to an inputted character string and storing the bit image data in a predetermined storage, each time a character string is inputted by the input means, layout means for laying out each of the stored bit image data for each layer, generating means for generating image data by overlaying each of the image data obtained by the layout means on the background image, and output means for outputting the image data, obtained by the generating means, to printing means.

The applied art, namely Attenberg and Drake, is not seen to disclose or suggest the foregoing combination of features of amended independent Claim 17, particularly with respect to selecting one of a plurality of background patterns displayed on the display screen by using the touch panel, background image display means for displaying on the display screen a background image corresponding to the pattern selected by the selection means, input means for inputting a plurality of character strings to be printed on a sticker, in association with a logical layer, control means for generating bit image data corresponding to an inputted character string and storing the bit image data in a predetermined storage, each time a character string is inputted by the input means, layout means for laying out each of the stored bit image data for each layer, generating means for generating image data by overlaying each of the image data obtained by the layout means on the background image, and output means for outputting the image data, obtained by the generating means, to printing means.

According to the foregoing invention of amended independent Claim 17, a plurality of character strings can be printed on a selected background image such that each of the character strings are overlaid with respect to each other in accordance with the layout thereof.

Attenberg is seen to be directed to an interactive photo kiosk in which a user's image is combined with a selected background image to form a composite image which is printed out on stickers. (Attenberg, abstract; Figs. 1 and 4; and column 4, lines 8 to 54). Although Attenberg creates a composite image, nowhere is Attenberg seen to disclose or suggest the input of character strings by the user which are incorporated into a composite image according to a predetermined format. In particular, nowhere is Attenberg seen to disclose or suggest input means for inputting a plurality of character strings to be printed on a sticker, in association with a logical layer, control means for generating bit image data corresponding to an inputted character string and storing the bit image data in a predetermined storage, each time a character string is inputted by the input means, layout means for laying out each of the stored bit image data for each layer, and generating means for generating image data by overlaying each of the image data obtained by the layout means on the background image.

In this regard, Drake is relied upon in the Office Action to allegedly teach the use of a virtual keyboard in a combination of features such as that of the present invention. Drake is seen to be directed to a bumper sticker printing machine which allows a user to select or input a message to be printed on a bumper sticker by using a touch screen. (Drake, Figs. 2 and 4(e); column 1, lines 45 to 51; and column 6, lines 42 to 50). As seen in Figure 4(e) of Drake, the touch screen for inputting letters is not seen to be in the form of a virtual keyboard, but is instead seen to be a scrolling rectangle box of letters.

(Drake, Fig. 4(e); and column 6, lines 42 to 60). Although the user in Drake can use touch screen 270 to input a bumper sticker message, Drake is not seen to provide for inputting a plurality of character strings to be printed on a sticker, in association with a logical layer, generating bit image data corresponding to an inputted character string and storing the bit image data in a predetermined storage, each time a character string is input, laying out each of the stored bit image data for each layer, and generating image data by overlaying each of the laid out image data on the background image, as in the present invention. In addition, nowhere is Drake seen to suggest using a virtual keyboard in combination with the foregoing features.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." M.P.E.P. § 2143.

Applicants respectfully submit that the applied references, either alone or in combination, for which combination no motivation or suggestion is seen, are not seen to disclose or suggest all of the claim limitations of amended independent Claim 17.

Accordingly, amended independent Claim 17 is believed to be in condition for allowance and such action is respectfully requested. In addition, amended independent Claims 25, 26, 27 and 28 are directed to method, computer-readable medium, apparatus, and sticker printing apparatus claims, respectively, which substantially include at least the aforementioned combination of features of amended independent Claim 17, and are

therefore also believed to be in condition for allowance for the same reasons discussed above with respect to amended independent Claim 17.

The remaining pending claims under consideration in this application are each dependent from the independent claims discussed above and are therefore believed patentable for the same reasons. Because each dependent claim is also deemed to define an additional aspect of the invention, however, the individual consideration of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, and no other matters being raised in the Office Action, the entire application is believed to be in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

Applicants' undersigned attorney may be reached in our Costa Mesa, CA office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,



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